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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/299,539	04/26/1999	ANTONIO MUNOZ-ESCALONA LAFUENTE	B-3643-61707	3400

36716 7590 10/28/2004

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EXAMINER	
PASTERCZYK, JAMES W	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/299,539	MUNOZ-ESCALONA LAFUENTE ET AL.
	Examiner	Art Unit
	J. Pasterczyk	1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10-18,20,21,23-25 and 27-39* is/are pending in the application.

4a) Of the above claim(s) *8,20,38 and 39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,10-18,21,23-25 and 27-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-8,10-18,20,21, 23-25 and 27-39* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. This Office action is in response to the amendment filed 9/27/04 and refers to the Office action mailed 4/21/04.

2. Claims 21, 25, 27-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 and its dependents 25 and 27-37 do not consistently use one term "composition" or "system" to refer to the subject matter sought to be protected by the claims, hence there is lack of clear, positive antecedent basis.

3. The obviousness type double patenting rejection against USSN 09/300302 is withdrawn due to its abandonment.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7, 10-18, 21, 23-25, and 27-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 08/961956. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims have only minor differences between the two applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The examiner notes that this copending case is still under prosecution and is now subject to appeal, though no appeal brief has yet been filed.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-7, 10-18, 21, 23-25 and 27-37 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hidalgo Llinas as cited in and for the reasons of record in the previous Office action.

8. Claims 1-7, 10-18, 21, 23-25 and 27-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Canich as cited in and for the reasons given in the previous Office action.

9. Claims 1-7, 10-18, 21, 23-25 and 27-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antberg in view of Welborn as cited in and for the reasons of record given in the previous Office action.

10. Applicant's arguments filed 9/27/04 have been fully considered but they are not persuasive.

Regarding the obviousness rejection over Antberg in view of Welborn, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that their invention results in lower fines in the polymer made using the catalyst of the present invention along with higher activity, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The obviousness rejection is based on the combination of the metallocenes of Antberg (top of p. 6) with the order of addition of ingredients of Welborn (p. 6, l. 15-19). Both the Me_3SiO groups on the metallocenes of Antberg and the aluminum alkyl groups of the alumoxane of Welborn would have been expected to react with surface hydroxyl and bridging oxide groups of the supports used by Welborn, whether or not functionalized, regardless of order of addition and depending on the stoichiometry of the reagents used.

Regarding the 35 USC 102/103 inherency rejections over Hidalgo Llinas and Canich, applicants seem to misconstrue their nature. They are not either/or rejections, but rejections that recognize that given the combination of ingredients used in the prior art, the product formed therein may very well be identical to that of the claims under consideration. Given that the

present claims are drafted in product-by-process format and hence actually claim a product, the process used to make the product is essentially immaterial since, absent a showing of a difference between the prior art product and the claimed product, the claims are presumed to be anticipated by the prior art according to the holding in *In re Best* as cited in the last Office action. In this case, as noted previously, the burden of proof shifts to applicants that the prior art does not actually anticipate the invention by providing a properly executed showing under 37 CFR 1.132, not mere attorney's argument and not the matter presented as it is in Appendix I of the latest amendment. Given that it would be reasonable to expect either a functionalized or non-functionalized support to react in whatever order with an alumoxane and a metallocene in whatever proportions to provide a composition in which both are covalently bonded to the support, the use of the 35 USC 102/103 inherency rejections was considered appropriate and remains in force.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700

J. Pasterczyk

AU 1755

10/22/04